Remarks/Arguments

The Withdrawal of Claims 16-23

In the previous Office Action Claims 16-23 were withdrawn from consideration by the Examiner due to amendments to the claims that resulted in the claims being directed to an invention that is independent or distinct from the invention originally claimed. The key phrase that was listed as setting the invention recited in Claim 16 as independent and distinct is "detachably positionable" instead of the original wording "detachably securable."

Claim 16 has been amended to delete that the drive mechanism is "detachably positionable" and replacing it with the phrase "detachably securable," as the claim was originally worded. Claims 16-23 now recite subcombinations that are related to the subcombinations recited in Claims 1-10, 12-15 and 24-33. Further limitations have also been added, but the wording that promulgated the forced withdrawal of Claims 16-23, i.e., the phrase "detachably securable," has been removed and those claims should be reinstated. While clarification of how the drive mechanism is detachably secured to the stage has been clarified with further limitations, the claims no longer recite an independent or distinct invention. Also, as Claim 16 is currently recited, it once again is a linking claim. Applicants respectfully request reinstatement of previously withdrawn Claims 16-23.

Patentability of Claims 16-23

Applicants submit that independent Claim 16 is patentable because the combined references of Stahl et al. and Kuroha fail to teach or disclose all of the limitations of Claim 16. The combination of Stahl et al. and Kuroha fails to teach or disclose a drive mechanism that is detachably securable to the right or the left side of the microscope stage. Also, Stahl et al. and Kuroha fail to teach or disclose a microscope stage with a first and a second hole on the stage that receives an end of the drive mechanism to accomplish the detachable securing of the drive mechanism to the stage. Therefore, a prima facie case of obviousness has not been established and Claim 16 is patentable.

Claims 17-23 are dependent on Claim 16 and therefore are also patentable due to that dependency. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 16-23 and passage to allowance of those claims.

The Provisional Rejection of Claims 1-2, 6 and 10-11 for Double Patenting

The Examiner rejected Claims 1-2, 6 and 10-11 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-34 of copending Application No. 10/810979. Applicants respectfully requests reconsideration. Please see the attached Terminal Disclaimer in the **Appendix** which is meant to obviate the provisional double patenting rejection.

The Rejection of Claims 1-2, 4, 6, 8, 10-11 Under 35 USC §103(a)

The Examiner rejected Claims 1-2, 4, 6, 8 and 10-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,402,576 (Stahl et al.) in view of U.S. Patent No. 4,097,116 (Kuroha). Applicants respectfully traverse this rejection and requests reconsideration.

Claim 1 has been amended to recite that the microscope stage drive mechanism has an end shaped to be detachably secured to the underside of said stage **on the left or the right side of said stage**.

Also, Claim 1 now recites that a first engagement means for a microscope stage drive mechanism is positioned at a first hole at a first location on the left side of the stage, wherein said **end of said drive mechanism is receivable into the first hole** to detachably secure said drive mechanism to said stage at said first location. A second engagement means for said microscope stage drive mechanism is positioned at a second hole at a second location on right side of the stage, wherein said **end of said drive mechanism is receivable into the second hole** to detachably secure said drive mechanism to said stage at said second location. This amendment is fully supported by the original specification, and no new matter has been added.

Claim 1

In order to establish a prima facie case of obvious all the limitations of a claim must be taught or suggested by the references that have been combined. Stahl et al. discloses a microscope adjusting device that is secured to one location on a microscope stage. Stahl et al. has no teaching or suggestion that the adjusting means can be attached at any location other than the single location depicted in the sole figure. The specification is also void of any reference to a drive mechanism that is alternatively attached to either a first or second engagement means on the left or the right side of the stage. There is also no teaching in Stahl et al. that the end of the drive mechanism is receivable into a first or second hole on the stage.

Stahl et al. discloses an adjusting device for a microscope that has a coaxial drive means and a common release mechanism for simultaneously disengaging both drive means to facilitate rapid manual displacement of the stages to an approximate desired position. (See Abstract). Common release mechanism 36 is not a structural element that enables drive means 21, 23 of stages 12, 13 to be detachable secured to the left or right side of the stage. Drive means 21, 23 are permanently located beneath cover 42 on a one side of the stage. There is no structural feature that would permit the microscope drive means disclosed by Stahl et al. to be positioned on the left of right side of the stage. The screws, which are cited as the structure capable of detachably securing the drive mechanism to the stage at to different location, is not equivalent to will not allow the Stahl et al. drive mechanism to be attached to the left or right side of the stage. The drive mechanism of Claim 1 has an end capable of inserting into a first or a second hole on the stage that allows the drive mechanism to be detachably secured to the left or right side of the stage. Thus, Stahl et al. fails to teach the first and second holes that the end of the drive mechanism is received into, the dual positions for attaching the drive mechanism to the right or left side of the stage, or a drive mechanism that can be removed and detachably secured to a stage by inserting the end of the mechanism into a hole in the stage.

Moreover, conventional microscopes are either left or right-handed models. Therefore, they are not adaptable to left or right-handed users. The invention recited in Claim 1 provides

the user with the alternative to control a single microscope from the left or right side. Giving the alternative to detachably secure the drive mechanism to either the first or second engagement means provides a single microscope is viable for either left or right-handed microscopists. Stahl et al. does not teach a microscope with that capability. More importantly, Stahl et al. fails to provide the structural elements of a microscope with a drive mechanism that can be attached to either a first location or a second location, i.e., left or right side.

Kuroha has been cited to teach that the attachment of a stage drive mechanism to a microscope stage via screws as evidence that attachment of a stage drive mechanism to a microscope stage with screws was known in the art. The detachable nature of the screws was not explicitly taught in Kuroha or Stahl et al., but the Examiner contends that it would have been obvious that the screws would be detachable. Amendments to Claim 1 have added limitations that are not taught by Stahl et al., which have been shown *supra*, and those limitations are also nonexistent in Kuroha. Specifically, Kuroha fails to teach or disclose a drive mechanism that can be detachably secured to the right or the left side of the microscope stage. Kuroha also fails to teach or disclose a drive mechanism that has an end that is inserted in a first or a second hole in the stage to detachably secure the drive mechanism to the stage.

For all the reasons stated above, Claim 1 is not taught or suggested by the combination of Stahl et al. and Kuroha. Applicants respectfully request reconsideration and passage to allowance of Claim 1.

Claims 2, 4, 6, 8, 10-11 are dependent on Claim 1, and due to that dependency carry all the limitations of Claim 1. Therefore, Claims 2, 4, 6, 8 and 10-11 are also patentable and Applicants respectfully request reconsideration and passage to allowance of Claims 2, 4, 6, 8 and 10-11.

The Rejection of Claims 3 and 7 Under 35 USC 103(a)

The Examiner rejected Claims 3 and 7 under 35 USC §103(a) as being unpatentable over Stahl et al. in view of Kuroha, and in further view of U.S. Patent No. 5,802,925 (Kanao). Applicants respectfully request reconsideration and traverse the rejection.

Applicants have shown that the combination of Stahl et al. and Kuroha fails to teach all the elements of the invention recited in Claim 1. Kanao fails to cure the defects of the combination of Stahl et al. and Kuroha. Therefore, since Kanao also fails to teach a microscope stage drive mechanism that can be detachably secured to the right or left side of the stage, and a microscope stage with a hole on the left side and the right side of the stage that receives the end of the detachably securable drive mechanism, a prima facie case of obviousness has not been provided by the combination of Stahl et al., Kuroha and Kanao. Therefore, Claim 1 is patentable over Stahl et al. in view of Kuroha, and in further view of Kanao. Claims 3 and 7 are dependent on Claim 1 and therefore have claim limitations that are also not taught by the combination of Stahl et al., Kuroha and Kanao. Therefore, Claims 3 and 7 are patentable over the combination of Stahl et al., Kuroha, and Kanao.

The Rejection of Claims 5 and 9 Under 35 USC 103(a)

The Examiner rejected Claims 5 and 9 under 35 USC §103(a) as being unpatentable over Stahl et al. in view of Kuroha, and in further view of U.S. Patent No. 3,428,387 (Chambers et al.). Applicants respectfully request reconsideration and traverse the rejection.

It has been shown above that Claim 1 is patentable over the combination of Stahl et al. and Kurora. Hall et al. fails to cure the defects of the combination of Stahl et al. and Kuroha. Namely, Hall et al. fails to teach a stage drive mechanism that can be detachably secured to the left or right side of the stage, and it fails to a microscope stage with a hole on the right and left side of the stage that receives an end of the stage drive mechanism in order to detachably secure the drive mechanism to the stage. Thus, the combination of Stahl et al., Kuroha and Hall et al. fails to teach all the recited elements of Claim 1. Therefore, Claim 1 is patentable over the

combination of Stahl et al., Kuroha and Hall et al. Claims 5 and 9 are dependent on Claim 1 and therefore have claim limitations that are also not taught by that same combination. Therefore, Claims 5 and 9 are patentable over the combination of Stahl et al., Kuroha and Hall et al.

Furthermore the element recited in Claims 5 and 9, a spring-loaded ball bearing, is not taught by Hall et al. Hall et al. teaches a pressure roller urged by a spring to engage the roller to press rod 25 into frictional engagement with V pulley 26. The spring-loaded ball bearing of Claims 5 and 9 is used to detachably secure the stage drive mechanism to the stage. It has nothing to due with preventing the slipping of the stage drive mechanism during use. In order to combine references to support an obviousness rejection there must be a suggestion or motivation to combine the cited references. In this case, the Examiner has stated that one of ordinary skill in the art would be motivated to combine Hall et al. with Stahl et al. since a spring urged roller would keep the drive mechanism from slipping. This motivation has been born out of improper hindsight reconstruction since such a spring urged roller is unnecessary to prevent the drive mechanism of the claimed invention from slipping. The use of a spring loaded ball bearing as recited in Claim 5 and 9 is to detachably secure the drive mechanism to the stage, not prevent slipping of the drive mechanism.

Furthermore, a spring loaded ball bearing is entirely different than a roller (or wheel) that is urged by a spring. A roller is not capable of receiving and holding a drive mechanism into mounting hole 24 as adeptly as a spring loaded ball bearing since it has smooth surfaces on only two sides of the wheel. A ball bearing has an entirely smooth surface, which can receive the drive mechanism from various angles. The roller or wheel that Hall et al. teaches, if implemented in the invention recited in Claims 5 and 9, would only accept the drive if it was inserted at an angle roughly perpendicular to the mounting hole (and that is only if the roller is oriented correctly). A smooth ball bearing can accommodate the insertion of a drive mechanism from various angles since it has a smooth surface that can yield to the drive mechanism from various acute angles. Therefore, the roller and spring taught by Hall et al. is not analogous to the spring-

loaded ball bearing recited in Claims 5 and 9, and this claim limitation is not taught by the combination of Stahl et al. and Hall et al.

For the reasons stated above Claims 5 and 9 are patentable over the combination of Stahl et al., Kuroha and Hall et al., and Applicants respectfully request that the rejection of those claims be withdrawn and Claims 5 and 9 passed to allowance.

Conclusion

Applicants respectfully submit that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,

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